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EXAMINER


HUTTON JR, WILLIAM D

| ART UNIT | PAPER NUMBER |
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2179

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/817,527 | Applicant(s) WHEWELL ET AL.  | |
| | Examiner Doug Hutton | Art Unit 2178 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

- the term “patent” on Page 3, Line 8 should be amended to — Patents — because it is the first word of the sentence.

Appropriate correction is required.

Claim Objections

Claim 3 is objected to because of the following informalities:

- the phrase “35 USC §102 of 35 USC §103” in Line 2 should be amended to — 35 USC §102 or 35 USC §103 — because it appears to be a typographic error.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-36:

The subject matter specified in the claims is non-statutory and fails to recite patent-eligible subject matter in that it is not in the technological arts.

Additionally, the claimed invention is so abstract and sweeping that it covers the method as practiced by a human operator assisted only by pencil and paper. The claims do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process," is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes,"* abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (emphasis added) *Gottschalk v. Benson*, 75 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing* U.S.P.Q. 571 (1969).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 16, 17, 22 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by <http://www.patents.com/cost.htm#patentable> (hereinafter, Patents).

Claim 1:

Patents discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Pages 1-7, especially the question and answer “What does it cost to get an opinion whether my invention is patentable?” on Pages 4-6 – the cited web page includes information about “patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given before the patent application is written and filed), said patentability search report comprising:

- a citing of one or more prior art documents which contains subject matter that is potentially material to the patentability of the alleged new invention (the patentability opinion cites prior art that is relevant to the invention);

- a written description describing the elements or features contained in such one or more prior art documents (the patentability opinion includes a description of the relevant prior art); and
- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention).

Claim 2:

Patents discloses a patent search report according to Claim 1, wherein said draft patent claim is written by a person registered to represent inventors before the United States Patent and Trademark Office (the attorneys are registered patent attorneys).

Claim 3:

Patents discloses a patent search report according to Claim 1, wherein said draft patent claim is not properly rejectable under any section of either 35 USC §102 or 35 USC §103 in view of any of said prior art documents (the patentability opinion, which includes a patentable claim, ***inherently*** includes a claim that is novel and nonobvious).

Claim 4:

Patents discloses a patent search report according to Claim 1, wherein said draft patent claim is in a claim format acceptable to the United States Patent and Trademark

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Office (the claims are drafted in a format that is acceptable to the USPTO).

Claim 5:

Patents discloses a patent search report according to Claim 1, comprising a plurality of draft patent claims (the patentability opinion includes a plurality of drafted claims).

Claim 6:

Patents discloses a patent search report according to Claim 1, further comprising:

- one or more written statements pointing out the differences between the elements or features contained in one or more of said prior art documents and the alleged new invention as described by said draft patent claim (the patentability opinion includes statements that point out the differences between the prior art and the invention).

Claim 7:

Patents discloses a patent search report according to Claim 1, further comprising:

- a written statement reflecting an opinion about the patentability of the alleged new invention as described in said draft patent claim in view of the prior art

documents cited (the patentability opinion includes an opinion regarding patentability of the drafted claims).

Claim 8:

Patents discloses a patent search report according to Claim 7, wherein said written statement includes a statement in reference to any section of 35 USC § 102 (the patentability opinion includes a statement regarding any possible 102 rejection).

Claim 9:

Patents discloses a patent search report according to Claim 7, wherein said written statement includes a statement in reference to any section of 35 USC § 103 (the patentability opinion includes a statement regarding any possible 103 rejection).

Claim 16:

Patents discloses a patent search report according to Claim 1, wherein one or more prior art documents cited describe subject matter selected from the group consisting of: a) an article of manufacture; b) a process; c) a composition of matter; d) a machine; and e) a method of doing business (the patentability opinion cites prior art that includes US patents, which include each of the recited items).

Claim 17:

Patents discloses a patent search report according to Claim 1, wherein said alleged new invention is an invention which falls within the statutory classes of patentable subject matter selected from the group consisting of: a) an article of manufacture; b) a process; c) a composition of matter; d) a machine; and e) a method of doing business (the new invention include at least one of the recited items).

Claim 22:

Patents discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Pages 1-7, especially the question and answer “What does it cost to get an opinion whether my invention is patentable?” on Pages 4-6 – the cited web page includes information about “patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given before the patent application is written and filed), said patentability search report comprising:

- a citing of one or more prior art documents which contains subject matter that is potentially material to the patentability of the alleged new invention (the patentability opinion cites prior art that is relevant to the invention);

- a written description describing the elements or features contained in such one or more prior art documents (the patentability opinion includes a description of the relevant prior art);
- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention);
- one or more written statements pointing out the differences between the elements or features contained in one or more of said prior art documents and the alleged new invention as described by said draft patent claim (the patentability opinion includes a comparison between the invention and the prior art that is collected); and
- a written statement reflecting an opinion about the patentability of the alleged new invention as described by said draft patent claim (the patentability opinion includes an opinion regarding the patentability of the invention).

Claim 27:

Patents discloses a process for providing a patentability search report concerning an alleged new invention prior to the filing of a patent application covering such alleged new invention, which search report contains a written evaluation of the patentability of the alleged new invention as compared with at least one prior art document (see Pages 1-7, especially the question and answer "What does it cost to get an opinion whether my invention is patentable?" on Pages 4-6 – the cited web page includes information about

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“patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given before the patent application is written and filed), the process comprising the steps of:

- reviewing documents contained in the prior art (the patentability opinion includes a prior art search);
- identifying one or more prior art documents that describe subject matter that is potentially material to the patentability of the subject invention (the patentability opinion cites prior art that is relevant to the invention);
- providing a written description of the identity of and the elements or features contained in such one or more prior art documents identified in b) (the patentability opinion includes a description of the relevant prior art); and
- providing at least one written draft patent claim, which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention).

Claim 28:

This claim recites the same limitation specified in Claim 2. Thus, Patents discloses every limitation of this claim using the same rationale indicated in the above 102 rejection for Claim 2.

Claim 29:

Patents discloses a process according to Claim 27, further comprising the step of:

- providing at least one written statement concerning the patentability of said draft patent claim in view of said one or more prior art document identified (the patentability opinion includes an opinion regarding the patentability of the invention).

Claims 30 and 31:

These claims recite the same limitations as Claims 8 and 9. Thus, Patents discloses every limitation of these claims using the same rationale indicated in the above 102 rejections for Claims 8 and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-15, 18-21, 23-26 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patents, in view of Kerven et al., U.S. Patent Application Publication No. US 2002/0042784 A1.

Claim 10:

As indicated in the above discussion, Patents discloses every limitation of Claim 6.

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection of said draft patent claim (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness that are processed into a draft office action from the PTO),
for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection of said draft patent claim for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claim 11:

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that conforms substantially to the form used by the United States Patent and Trademark Office in rejecting patent claims in applications pending before it (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness that are processed into a draft office action from the PTO),

for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection that conforms substantially to the form used by the United States Patent and Trademark Office in rejecting patent claims in applications pending before it for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claim 12:

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that is written by a person registered to represent inventors before the United States Patent and Trademark Office (the search report, which includes the mock rejection, is reviewed, revised and finalized by

an attorney that is registered to represent inventors before the United States Patent and Trademark Office),
for the purpose of reviewing and finalizing the automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection of said draft patent claim for the purpose of reviewing and finalizing the automated analysis of the search results, as taught by Kerven.

Claim 13:

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that includes a statement in reference to any section of 35 USC §102 (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness that are processed into a draft office action from the PTO),

for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection that includes a statement in reference to any section of

35 USC §102 for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claim 14:

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that includes a statement in reference to any section of 35 USC §103 (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness that are processed into a draft office action from the PTO),

for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection that includes a statement in reference to any section of 35 USC §103 for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claim 15:

Patents, in view of Kerven, discloses every limitation of Claim 10.

Patents, in view of Kerven, fails to expressly disclose a written statement describing at least one means for potentially obviating said mock rejection. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include, in the search report, a written statement describing at least one means for potentially obviating said mock rejection. Patent attorneys have been submitting arguments for patentability in response to rejections under 35 USC §102 and 35 USC §103 for many years for the purpose of obtaining patents for the applicants.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, in view of Kerven, to include a written statement describing at least one means for potentially obviating said mock rejection for the purpose of obtaining patents for the applicants.

Claim 18:

Patents discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Pages 1-7, especially the question and answer “What does it cost to get an opinion whether my invention is patentable?” on Pages 4-6 – the cited web page includes information about “patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given

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before the patent application is written and filed), said patentability search report comprising:

- a citing of one or more prior art documents which contains subject matter that is potentially material to the patentability of the alleged new invention (the patentability opinion cites prior art that is relevant to the invention);
- a written description describing the elements or features contained in such one or more prior art documents (the patentability opinion includes a description of the relevant prior art); and
- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention).

Patents fails to expressly disclose a written mock rejection of said draft patent claim.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that is based at least in part on the presence or arrangement of elements or features contained in at least one of said prior art documents in said citing, wherein said mock rejection is written by a person registered to represent inventors before the United States Patent and Trademark Office (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness, based on the prior art found in the search,

that are processed into a draft office action from the PTO; the search report is reviewed, revised and finalized by an attorney that is registered to represent inventors before the United States Patent and Trademark Office), for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Patents, to include a written mock rejection that is based at least in part on the presence or arrangement of elements or features contained in at least one of said prior art documents in said citing, wherein said mock rejection is written by a person registered to represent inventors before the United States Patent and Trademark Office for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claims 19 and 25:

These claims recite the same limitations as Claim 3. Thus, Patents discloses every limitation of these claims using the same rationale indicated in the above 102 rejection for Claim 3.

Claims 20 and 26:

These claims recite the same limitation as Claim 4. Thus, Patents discloses every limitation of these claims using the same rationale indicated in the above 102 rejection for Claim 4.

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Claims 21, 24 and 36:

These claims recite the same limitation as Claim 15. Thus, Patents, in view of Kerven, discloses/teaches every limitation of these claims using the same rationale indicated in the above 103 rejection for Claim 15.

Claim 23:

This claim recites the same “written mock rejection” limitation specified in Claim 18. Thus, Patents, in view of Kerven, discloses/teaches every limitation of this claim using the same rationale indicated in the above 103 rejection for Claim 18.

Claim 32:

This claim recites the same limitations specified in Claim 10. Thus, Patents, in view of Kerven, discloses/teaches every limitation of this claim using the same rationale indicated in the above 103 rejection for Claim 10.

Claim 33:

This claim recites the same limitations specified in Claim 11. Thus, Patents, in view of Kerven, discloses/teaches every limitation of this claim using the same rationale indicated in the above 103 rejection for Claim 11.

Claims 34 and 35:

These claims recite the subject matter within the scope of Claims 13 and 14, respectively. Thus, Patents, in view of Kerven, discloses/teaches every limitation of these claims using the same rationale indicated in the above 103 rejection for Claims 13 and 14.

Claims 1-9, 16, 17, 22 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Admission), in view of Patents.

Claim 1:

Admission discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Specification of present application, Pages 1-6), said patentability search report comprising:

- a citing of one or more prior art documents which contains subject matter that is potentially material to the patentability of the alleged new invention (see Page 3, last partial paragraph through Page 4, first partial paragraph); and
- a written description describing the elements or features contained in such one or more prior art documents (see Page 6, first paragraph).

Admission fails to disclose a patentability search report comprising:

- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention.

Patents discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Pages 1-7, especially the question and answer “What does it cost to get an opinion whether my invention is patentable?” on Pages 4-6 – the cited web page includes information about “patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given before the patent application is written and filed), said patentability search report comprising:

- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention),

for the purpose of evaluating one’s chances of obtaining a patent.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, to include at least one written draft patent claim which draft claim embraces a point of

novelty of the alleged new invention for the purpose of evaluating one's chances of obtaining a patent, as taught by Patents.

Claim 22:

As indicated in the above rejection for Claim 1, Admission discloses limitations "a)" and "b)."

As indicated in the above rejection for Claim 22, Patents discloses limitations "c)," "d)" and "e)" for the purpose of evaluating one's chances of obtaining a patent.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, to include limitations "c)," "d)" and "e)" for the purpose of evaluating one's chances of obtaining a patent, as taught by Patents.

Claim 27:

Admission discloses a process for providing a patentability search report concerning an alleged new invention prior to the filing of a patent application covering such alleged new invention, which search report contains a written evaluation of the patentability of the alleged new invention as compared with at least one prior art document (see Specification of present application, Pages 1-6), the process comprising the steps of:

- reviewing documents contained in the prior art (see Pages 1-6 – the prior art search includes a review of documents in the prior art);

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- identifying one or more prior art documents that describe subject matter that is potentially material to the patentability of the subject invention (see Page 3, last partial paragraph through Page 4, first partial paragraph);
- providing a written description of the identity of and the elements or features contained in such one or more prior art documents identified in b) (see Page 6, first paragraph).

Admission fails to expressly disclose a process for providing a patentability search report, comprising the step of:

- providing at least one written draft patent claim, which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention).

Patents discloses a process for providing a patentability search report, comprising the step of:

- providing at least one written draft patent claim, which draft claim embraces a point of novelty of the alleged new invention (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention),

for the purpose of evaluating one's chances of obtaining a patent.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process for providing a patentability search report, disclosed in Admission, to include the step of:

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- providing at least one written draft patent claim, which draft claim embraces a point of novelty of the alleged new invention,

for the purpose of evaluating one's chances of obtaining a patent, as taught by Patents.

Claims 2-9 16, 17, and 28-31:

Admission fails to expressly disclose the limitations of these claims.

Patents teaches every limitation of these claims, as indicated in the above rejections for Claims 2-9, 16, 17 and 28-31, for the purpose of evaluating one's chances of obtaining a patent.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, to include every limitation recited in Claims 2-9, 16, 17 and 28-31 for the purpose of evaluating one's chances of obtaining a patent, as taught by Patents.

Claims 10-15, 18-21, 23-26 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admission, in view of Patents, and further in view of Kerven.

Claim 18:

Admission discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such

alleged new invention (see Specification of present application, Pages 1-6), said patentability search report comprising:

- a citing of one or more prior art documents which contains subject matter that is potentially material to the patentability of the alleged new invention (see Page 3, last partial paragraph through Page 4, first partial paragraph); and
- a written description describing the elements or features contained in such one or more prior art documents (see Page 6, first paragraph).

Admission fails to disclose a patentability search report comprising:

- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention.

Patents discloses a patentability search report concerning an alleged new invention, which search report contains a written evaluation of the patentability of such alleged new invention as compared with at least one prior art document, and wherein such search report is created prior to the filing of a patent application covering such alleged new invention (see Pages 1-7, especially the question and answer “What does it cost to get an opinion whether my invention is patentable?” on Pages 4-6 – the cited web page includes information about “patentability opinions” regarding the patentability of an invention as compared with the prior art; said patentability opinion being given before the patent application is written and filed), said patentability search report comprising:

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- at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention, wherein said draft patent claim is written by a person registered to represent inventors before the United States Patent and Trademark Office (the patentability opinion includes drafting a patent claim that sets forth the novelty of the invention; the attorneys are registered patent attorneys),

for the purpose of evaluating one's chances of obtaining a patent.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, to include at least one written draft patent claim which draft claim embraces a point of novelty of the alleged new invention, wherein said draft patent claim is written by a person registered to represent inventors before the United States Patent and Trademark Office, for the purpose of evaluating one's chances of obtaining a patent, as taught by Patents.

Admission, in view of Patents, fails to disclose a patentability search report comprising:

- a written mock rejection that is based at least in part on the presence or arrangement of elements or features contained in at least one of said prior art documents in said citing.

Kerven teaches a patentability search report (see Figures 1-2; see Paragraphs 0001-0121), comprising:

- a written mock rejection that is based at least in part on the presence or arrangement of elements or features contained in at least one of said prior art documents in said citing, wherein said mock rejection is written by a person registered to represent inventors before the United States Patent and Trademark Office (the search report includes reasons for rejections of the subject claim for lack of novelty and/or obviousness, based on the prior art found in the search, that are processed into a draft office action from the PTO; the search report is reviewed, revised and finalized by an attorney that is registered to represent inventors before the United States Patent and Trademark Office), for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, in view of Patents, to include a written mock rejection that is based at least in part on the presence or arrangement of elements or features contained in at least one of said prior art documents in said citing, wherein said mock rejection is written by a person registered to represent inventors before the United States Patent and Trademark Office for the purpose of providing automated analysis of the search results, as taught by Kerven.

Claims 19 and 20:

These claims recite the subject matter recited in Claims 3 and 4, respectively. Thus, Admission, in view of Patents, discloses/teaches every limitation of these claims using the same rationale indicated in the above 103 rejection for Claims 3 and 4.

Claims 21:

Admission, in view of Patents, and further in view of Kerven, fails to expressly disclose a written statement describing at least one means for potentially obviating said mock rejection. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include, in the search report, a written statement describing at least one means for potentially obviating said mock rejection. Patent attorneys have been submitting arguments for patentability in response to rejections under 35 USC §102 and 35 USC §103 for many years for the purpose of obtaining patents for the applicants.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, in view of Patents, and further in view of Kerven, to include a written statement describing at least one means for potentially obviating said mock rejection for the purpose of obtaining patents for the applicants.

Claims 10-15, 23-26 and 32-36:

Admission, in view of Patents, discloses the limitations of Claims 6, 22 and 27.

Admission, in view of Patents, fails to expressly disclose the limitations of Claims 10-15, 23-26 and 32-36.

Kerven teaches the limitations of these claims, as indicated in the above rejections, for the purpose of providing automated analysis of the search results.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the search report, disclosed in Admission, in view of Patents, to include the limitations of these claims for the purpose of providing automated analysis of the search results, as taught by Kerven.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ronai, U.S. Patent Application Publication No. US 2002/0107896 A1; and Petruzzi et al., U.S. Patent No. 6,049,811.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

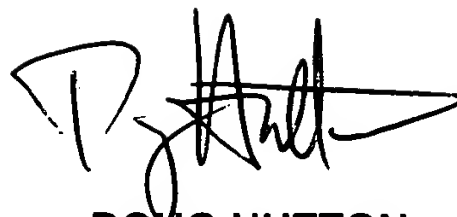
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WDH

August 5, 2004

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized, sweeping flourish extending to the right.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**